

REMARKS

Claims 1, 2, 4-6, and 8-26 are pending in the application. Claims 11, 12, and 16-25 are withdrawn from consideration as being directed to non-elected subject matter, where at least claims 11 and 12 are subject to rejoinder. Claims 1, 4, 8, 10, 14, and 26 are amended by the present amendment.

The changes to claims 4, 8, 10, and 14 are non-substantive. The amendments to independent claims 1 and 26 are fully supported by the specification as originally filed (see, e.g., paragraphs 0047 to 0051 of the specification; FIGS. 3A to 3D; and original claims 3 and 7). Claims 3 and 7 are canceled without prejudice.

Claims 1-4, 6, 9, and 26 are rejected under 35 USC 102(e) over U.S. Patent 6,296,639 to Truckai et al. (hereinafter "Truckai"). Claims 5, 7, 8, 10, and 13-15 are rejected under 35 USC 103(a) over Truckai. Applicants traverse these rejections.

Amended independent claim 1 recites a morcellator comprising a rotatable electrode at least partially housed in an outer sheath, and a tissue guider moveable with respect to the outer sheath for directing a tissue segment to the rotatable electrode for morcellation. Amended independent claim 26 recites similar elements of a morcellator, but uses "means plus function" language.

In Truckai, tissue ablation device 40 includes an energy conductive device 50 such as an elastic wire. The wire 50 can be bowed outwardly (see column 9, lines 39-46). During use, the wire 50 is advanced radially outwardly and is inserted into tissue to remove successive layers of the tissue (see FIGS. 6B to 6D; column 9, lines 56-67). The other versions of the ablation device disclosed in Truckai also involve advancing an ablation element outward and directly into tissue to ablate that tissue.

Truckai at least fails to teach or suggest the tissue guider recited in amended independent claim 1 and the directing means recited in amended independent claim 26. In Truckai, such a device and function is unnecessary because Truckai's wire and other disclosed ablation elements project outward and directly contact tissue. In Truckai, there is no need for or disclosure about directing tissue to an electrode for morcellation.

Applicants particularly traverse the assertion in the Office action about the obviousness of original claim 7. Truckai simply does not teach or suggest anything about the claimed tissue guider or the claimed directing means.

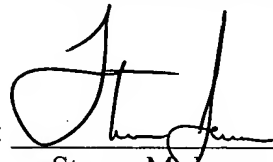
Applicants submit that claims 1, 2, 4-6, 8-10, 13-15, and 26 are in condition for immediate allowance, which action is earnestly solicited. Applicants also submit that withdrawn claims 11 and 12 should be rejoined. After the allowability of claims 1, 2, 4-6, 8-10, 13-15, and 26, applicants can amend to address the dependency of claim 11 and to eliminate the other withdrawn claims.

Respectfully submitted,

EDWARDS & ANGELL, LLP

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By: _____



Steven M. Jensen
(Reg. No. 42,693)

P.O. Box 55874
Boston, MA 02205

Phone: (617) 439-4444

Customer No. 21874